

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/525,581 Confirmation No.: 7012
Applicant : Paul Douglas et al.
Title : MOBILE 3-PART CRUSHER ASSEMBLY
Filed : February 22, 2005
Docket No. : 7881.17
Customer No. : 21999

RENEWED PETITION UNDER 37 C.F.R. 1.47(a)
REGARDING NONSIGNING INVENTOR

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Renewed Petition is filed in response to the Decision dated 14 September 2006. A Petition for Extension of Time (three months) is filed concurrently herewith to extend the response deadline until 14 February 2007.

On 31 July 2006, Applicants filed a Petition Under 37 CFR 1.47(a), which Petition and its enclosures are incorporated by reference. The Decision dated 14 September 2006 dismissed the Petition on the grounds that it failed to contain sufficient evidence that a complete copy of the national stage application was provided to the Paul Douglas ("Douglas"), the nonsigning inventor named in the above-identified patent application.

Enclosed is a signed "Witness Statement" (which has been averred as being truthful) by Mr. William McLean Orr, the European attorney of Extec Screens & Crushes Limited ("Extec"), the assignee of this patent application. The Orr Statement shows proof of the pertinent facts that a complete copy of the application papers has been presented to the nonsigning inventor Douglas with a clear request to sign and return the papers. Two letters dated September 23, 2005 and September 28, 2005 (Enclosure A) were sent to Douglas forwarding assignment and declaration documents to be signed and returned, and no response was made. Another letter dated November 14, 2006 (Enclosure B) was sent to Douglas forwarding declaration and assignment documents to be signed and returned, and again no response was made. This letter was delivered November 16, 2006, as shown on the acknowledgement of receipt provided as Enclosure C.

Finally, a letter dated November 28, 2006 (Enclosure D) was sent to Douglas forwarding a full copy of the specification, claims, and drawings comprising the PCT application upon which this U.S. patent application is based and containing a request to sign and return the declaration and assignment forms. This letter was delivered on December 1, 2006, as shown on the acknowledgement of receipt provided as Enclosure E.

As established by the Witness Statement signed by Ian Frazer English accompanying the Petition filed 31 July 2006, Douglas clearly has a legal and contractual duty to sign the application papers. However, "Douglas is being totally non-cooperative, and refusing to sign any forms."

The last known address for Paul Douglas is as follows:

17 Woodville Road
Hatrshorne, Derbyshire, DE11 7ET
United Kingdom

The Petition fee set forth in 37 C.F.R. 1.17(g) was previously submitted and, according to the Decision, no additional petition fee is required.

Applicant respectfully submits that the nonsigning inventor has been presented with a copy of the complete application papers and has refused to execute the application in accordance with the requirements of 37 CFR 1.47(a) and MPEP § 409.03(d). Applicant respectfully requests that this Petition be Granted.

Respectfully submitted,

/Evan R. Witt/

Evan R. Witt
Reg. No. 32,512
Attorney for Applicant

Date: February 13, 2007

KIRTON & McCONKIE
1800 Eagle Gate Tower
60 East South Temple
Salt Lake City, Utah 84111
Telephone: 801/328-3600

IN THE MATTER OF US PATENT
APPLICATIONS BASED ON
INTERNATIONAL PATENT
APPLICATIONS NAMING EXTEC
SCREENS & CRUSHERS LIMITED
AS APPLICANT AND PAUL
DOUGLAS AS INVENTOR OR
CO-INVENTOR

WITNESS STATEMENT

I, William McLean Orr, European and Chartered Patent Attorney, of Urquhart-Dykes & Lord
LLP, and Patent Attorney to Extec Screens & Crushers Limited, do hereby declare as follows:

1. This declaration is made in connection with 4 U.S. patent applications which have been
filed, based on International Patent Applications made in the name of Extec Screens & Crushers
Limited, and naming Paul Douglas as inventor or co-inventor. The details of the 4 cases are set
out below:

(i.) U.S. Application Serial No. 10/525,581 based on International Patent Application
No. PCT/GB2003/002855;

(ii.) U.S. Application Serial No. 10/550,036 based on International Patent Application
No. PCT/GB2004/001185;

(iii.) U.S. Application Serial No. 10/550,035 based on International Patent Application
No. PCT/GB2004/01183;

(iv.) U.S. Application Serial No. 11/568,305 based on International Patent Application
No. PCT/GB2005/001411.

2. I have represented Extec Screens & Crushers Limited, and predecessor Extec companies,
for in excess of fifteen years.

3. The 4 United States patent applications identified in paragraph 1 name Paul Douglas as inventor or as co-inventor, and have been derived from International patent applications made in the name of Extec Screens & Crushers Limited as applicant, and also naming Paul Douglas as inventor or as co-inventor.

5

4. I was responsible for the preparation of the specifications filed with the International patent applications, and which were duly reviewed by the inventor prior to the filing of the International applications, on which the present United States application is based.

10 5. I have made repeated requests in writing to inventor Douglas, to his personal address at 17 Woodville Road, Hartshorne, Derbyshire, DE11 7ET, United Kingdom, forwarding inventor declaration and assignment forms, and none have been returned to me.

15 6. In connection specifically with U.S. application No.10/525,581, I first sent forms to inventor Douglas by letters dated September 23, 2005 and September 28, 2005, of which copies are attached as enclosure A. No response was made to these letters.

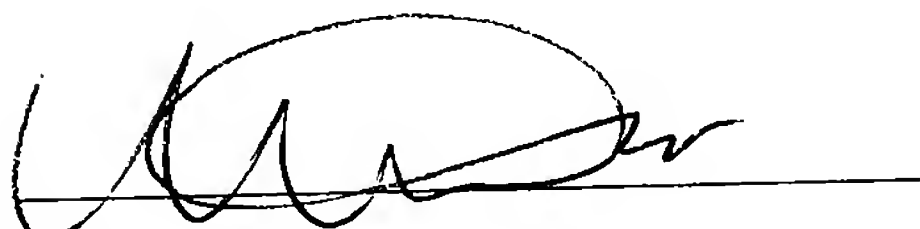
20 7. Subsequently, by letter sent recorded delivery on November 14, 2006, further request was made for inventor Douglas to sign the forms, which again received no response. Copies are attached as enclosure B, together with acknowledgement of receipt as enclosure C.

25 8. Finally, by letter dated November 28, 2006, also sent by registered post, I sent copies of 3 PCT applications referred to in the letter of November 14, 2006, (of which PCT/GB2003/002855 is the basis of US application 10/525,581, and full copy of the specification, claims and drawings of which were forwarded with the letter of November 28, 2006). Copy of this letter is attached as enclosure D. Proof of delivery of letter of November 28, 2006 to Paul Douglas is attached as enclosure E. No response was made to this letter.

I believe that the facts stated in this Witness Statement are true.

I also hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that wilful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such wilful false
5 statements may jeopardize the validity of the application or any patent issued thereon.

10

A handwritten signature in black ink, appearing to read 'William McLean Orr', written over a horizontal line.

William McLean Orr

dated February 8, 2007

ENCLOSURE A

23 August 2005

Mr Paul Douglas
17 Woodville Road
Hartshorne
Derbyshire
DE11 7ET



Intellectual property
Urquhart-Dykes & Lord LLP
Tower North Central
Merrion Way
Leeds
GB-LS2 8PA

T +44 (0)113 245 2388
F +44 (0)113 243 0446
E email@udl.co.uk
W www.udl.co.uk

Your ref:
Our ref: WMO/SL/P200452US

Dear Paul

Re: **US Patent Application No. 10/525,581**
Mobile 3-part Crusher Assembly

Can I ask you please to sign the enclosed US patent forms and return to us as a matter of urgency.

This is a case which Extec instructed us to file, and which names you and Terence Bratton as co-inventors.

I believe that Extec will have forwarded these forms to you some months ago, but we have no record as having received them back.

An addressed envelope is enclosed for your use.

Kind regards

Yours sincerely

W M ORR
for Urquhart-Dykes & Lord LLP

28 September 2005
URGENT

Mr Paul Douglas
17 Woodville Road
Hartshorne
Derbyshire
DE11 7ET

Urquhart-Dykes & Lord LLP
Tower North Central
Merrion Way
Leeds
GB-LS2 8PA

T +44 (0)113 245 2388
F +44 (0)113 243 0446
E email@udl.co.uk
W www.udl.co.uk

Your ref:
Our ref: WMO/SL/P200452US

Dear Paul

Re: **US Patent Application No. 10/525,581**
Mobile 3-part Crusher Assembly

Can I ask you please to sign the enclosed US Patent forms and return to us as a matter of urgency.

This is a case which Extec instructed us to file, and which names you and Terence Bratton as co-inventors.

An addressed envelope is enclosed for your use.

Kind regards

Yours sincerely

W M ORR
for Urquhart-Dykes & Lord LLP

ENCLOSURE B

Received

14 November 2006
RECORDED DELIVERY

16/NOV.



Intellectual property

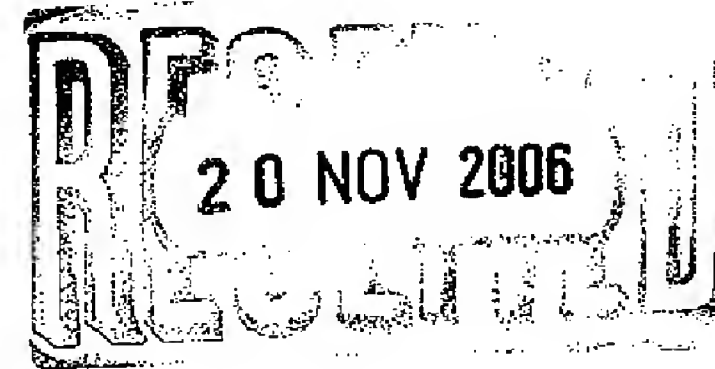
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Leeds
GB-LS2 8PA

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F +44 (0)113 243 0446
E email@udl.co.uk
W www.udl.co.uk

Mr Paul Douglas
17 Woodville Road
Hartshorne
Derbyshire
DE11 7ET

ENCLOSURE B

Your ref:
Our ref: WMO/SL/P200452US



Dear Paul

Re: US Patent Applications Naming Paul Douglas
As Inventor Or Co-inventor

**PLEASE SEE ATTACHED SECOND COPY FOR
YOU TO SIGN AND RETURN TO US**

As you will know, Extec has instructed us to apply for a number of US patent applications, in which you have been named as inventor or co-inventor. These cases relate to the time when you were an executive officer of the company, and specifically in charge of technical development of new products.

By virtue of your contract of employment, and the nature of your employment, it is fully settled UK employment law that all inventions made by you during the course of your employment are the property of your employer, namely Extec Screens & Crushers Limited.

Furthermore, as part of your termination agreement when you left employment of Extec, you clearly undertook to cooperate with Extec in signing any inventor forms which may be required.

We have sent numerous sets of forms to you for signature, plus many reminders, but none of these have been returned to us completed. We have informed the US Patent Office of your non-cooperation, but they are insisting that we give you every opportunity to sign in your capacity as named inventor, and we are therefore required to ask you yet again whether you will cooperate with us on this matter.

I am therefore now forwarding three further sets of inventor declaration and assignment forms, in respect of the following three cases listed below:

1. Crusher Slew Feeder - New US Patent Application based on International application No. PCT/GB2005/001411;
2. Mobile 3-part Crusher Assembly - US Application Serial No. 10/525,581; and
3. Crusher With Endless Track Wear Plates - US Application Serial No. 10/550,036.

If you remain unwilling to cooperate, I will be obliged to continue to seek your cooperation, and no doubt send many more reminder letters and additional sets of forms. To avoid you being troubled with all of this, if you remain of the view that you will not cooperate, perhaps you could kindly indicate as such on an additional copy of this letter, on which I have typed

out as an additional clause, your indication of unwillingness to cooperate in the matter, and a place for you to sign and date, and then to return to us. If this is done, then I will not need to trouble you any further, and I believe this will be sufficient for the purposes of the US Patent Office.

Kind regards

Yours sincerely

W M ORR
for Urquhart-Dykes & Lord LLP

I, Paul Douglas confirm having received this letter, and that I am not willing to sign the inventor declaration and assignment forms naming me as inventor on the three cases identified above.

.....
Paul Douglas

.....
Date

ENCLOSURE C

WMO

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ENCLOSURE D

28 November 2006

Registered Post


Mr Paul Douglas
17 Woodville Road
Hartshorne
Derbyshire
DE11 7ET

Urquhart-Dykes & Lord LLP
Tower North Central
Merrion Way
Leeds
GB-LS2 8PA

T +44 (0)113 245 2388
F +44 (0)113 243 0446
E email@udl.co.uk
W www.udl.co.uk

Your ref:

Our ref: WMO/MPW/P200452US

Enclosure 

Dear Paul

Re: US Patent Applications Naming Paul Douglas as Inventor or Co-inventor

I enclose a further copy of my letter of 14 November 2006, and would ask you please to sign this letter on page 2 and return to me as soon as possible. This signature is required by the US Patent Office, to confirm that you are not willing to sign the inventor Declaration and Assignment forms, and if you would please do this, I will not need to trouble you any further.

I am also obliged by the US Patent Office to forward copies to you of the three basic PCT cases on which the US filings were made, and therefore these are also forwarded herewith for your information. These are the cases "Crusher Slew Feeder", "Mobile 3-Part Crusher Assembly" and "Crusher with Endless Track Wear Plates", which were filed when you were still an employee of Extec, and on which Extec have instructed me to file corresponding US patents.

Yours sincerely

W M ORR

for Urquhart-Dykes & Lord LLP

Enc.

ENCLOSURE E

Despatch Receipt

Your company name and address

Postcode



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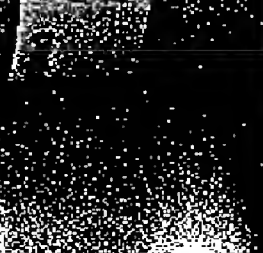
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